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No. 08-583

In the Supreme Court of the United States

ENERGIZER HOLDINGS, INC., ET AL., PETITIONERS

v.

INTERNATIONAL TRADE COMMISSION, ET AL.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR THE FEDERAL RESPONDENT IN OPPOSITION

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QUESTION PRESENTED

Whether petitioners' patent claims are invalid for failure to set forth a written description of the claimed invention, see 35 U.S.C. 112 para. 1, or for indefiniteness, see 35 U.S.C. 112 para. 2.

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OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-47a) is unreported. The decision of the International Trade Commission (Pet. App. 48a-75a) is unreported. An earlier opinion of the court of appeals (Pet. App. 76a-88a) is reported at 435 F.2d 1366. An earlier decision of the International Trade Commission (a redacted version of which is reprinted at Pet. App. 89a-125a) is unreported. The decision of the administrative law judge (excerpts of the public portion of which are reprinted at Pet. App. 126a-146a) is unreported.

JURISDICTION

The judgment of the court of appeals was entered on April 21, 2008. A petition for rehearing was denied on

August 1, 2008 (Pet. App. 147a-149a). The petition for a writ of certiorari was filed on October 30, 2008. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

Petitioners filed a complaint with the International Trade Commission (Commission) alleging violations of Section 337 of the Tariff Act of 1930, ch. 497, 46 Stat. 703, which prohibits "[t]he importation into the United States, the sale for importation, or the sale within the United States after importation * * * of articles that infringe a valid and enforceable United States patent." 19 U.S.C. 1337(a)(1)(B). The complaint was based on the importation and sale by intervenor-respondents of certain zero-mercury-added alkaline batteries. Petitioners alleged that the intervenor-respondents had infringed claims 1 through 7 of United States Patent No. 5,464,709 ('709 patent). Pet. App. 5a.[1]

The Commission terminated its investigation after concluding that the asserted claims of the '709 patent were invalid for failure to meet the definiteness requirement of 35 U.S.C. 112 para. 2. Pet. App. 89a-125a. The court of appeals reversed and remanded. *Id.* at 76a-88a. On remand, the Commission determined that the claims of the patent were invalid for failure to meet the written description requirement of 35 U.S.C. 112 para. 1, and that, if valid, the claims were not infringed by the imported products. Pet. App. 48a-75a. The court of appeals affirmed the judgment. *Id.* at 1a-47a.

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[1] Petitioners initially alleged infringement of Claims 1 through 12 of the '709 patent. During the course of the investigation, however, petitioners abandoned their allegation that Claims 8 through 12 had been infringed. Pet. App. 5a.

1. a. The patent statute provides that "[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains * * * to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention." 35 U.S.C. 112 para. 1. The statute further provides that "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. 112 para. 2. The "claim" is "the portion of the patent document that defines the scope of the patentee's rights." *Markman* v. *Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996).

b. The specification of the '709 patent purports to describe alkaline cells or batteries that are "substantially free of mercury" due to the inclusion of a multicomponent "anode gel" that uses so-called "low expansion" zinc as the "active anode material." Pet. Supp. App. SA4. The so-called "low expansion" zinc used in the anode gel is selected from available zinc powders by using a test to measure the expansion rate of a test anode gel mix made from 63 grams of the zinc powder being screened. The test employs a special electrochemical test cell and apparatus described in the specification. Zinc powders that pass the test, known as "low expansion" zincs, may then be combined with other materials to make the anode gels of the alkaline cells. See Pet. App. 99a-100a. The specification describes the anode gel as the anode of the claimed alkaline cell and the powdered zinc as the active anode component of that anode. *Id.* at 115a.

Claim 1 of the '709 patent, on which claims 2 through 7 depend, claims a commercial battery. Pet. App. 8a. Claim 1 sets forth the claimed invention as follows:

> An electrochemical cell comprising an alkaline electrolyte, a cathode comprising manganese dioxide as an active cathode component, and an anode gel comprised of zinc as the active anode component, wherein the cell contains less than 50 parts of mercury per million parts by weight of the cell and said zinc anode has a gel expansion of less than 25% after being discharged for 161 minutes to 15% depth of discharge at 2.88A.

Ibid.

2. The administrative law judge (ALJ) ruled for petitioners on their Section 337 complaint, concluding that their patent claims were valid and that the claims had been infringed. Pet. App. 127a. The ALJ explained that "[t]he main dispute among the parties is whether the term 'said zinc anode' [in Claim 1 of the patent] refers to the 'anode' previously mentioned in the claim or to the 'zinc as the active anode component.'" *Id.* at 136a. The ALJ noted the parties' agreement "that the term 'said zinc anode' lacks an antecedent basis in the claim," *i.e.*, that the term "zinc anode" does not appear in the claim before the term "said zinc anode." *Id.* at 137a. He also noted petitioners' acknowledgment that the term was ambiguous, and that it "even appears that 'said zinc anode' is referring to the anode gel of the electrochemical cell." *Id.* at 138a. The ALJ concluded, however, that an amendment made by the applicant while the '709 patent application was pending before the Patent and Trademark Office made clear that the applicant's "intention was that the 'said zinc anode' refer to the zinc." *Id.* at

140a. That amendment had deleted the word "gel" from the phrase "said zinc anode gel," explaining that "[i]t is the zinc which is to be tested, as set forth in the specification." *Ibid.* (citation omitted).

3. On review, the Commission reversed, concluding that the claims of the patent were invalid for indefiniteness. Pet. App. 89a-125a. The Commission rejected petitioners' argument that the term "said zinc anode" means "said zinc" or "said zinc as the active anode component." The Commission explained that such a construction would effectively read the word "anode" out of the term "said zinc anode" and thus would constitute an impermissible rewriting of the claims. *Id.* at 119a-125a. The Commission rejected the prosecution history relied on by the ALJ, explaining that, "[i]f anything, it further indicates that [petitioners] erred in drafting [C]laim 1." *Id.* at 121a. The Commission noted the inventor's testimony in that regard: "I think that word 'anode' actually was there in error. It should have said zinc powder that was used in the zinc anode." 2/23/04 Tr. 721-722.[2]

The Commission also rejected intervenor-respondents' proposed construction of the term "said zinc anode" as referring to "anode gel." The Commission explained that, if that reading of the disputed term were adopted, "the claim would then require [that] the anode gel of the 'electrochemical cell' (the alkaline cell destined for consumers) be 'discharged for 161 minutes to

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[2] The Commission quoted that testimony in its decision but redacted it from the original public version at petitioners' request. Although petitioners withdrew that request, see Letter from Sarah E. Hamblin, Esq. to Wayne Herrington, Esq., Office of Gen. Counsel, U.S. Int'l Trade Comm'n (Jan. 24, 2005), the petition appendix reproduces the Commission's opinion with that testimony redacted. See Pet. App. 121a-122a.

15% depth of discharge at 2.88A,' language that the specification associates only with the measurement or test cell, which is not referred to in the claim." Pet. App. 122a. The Commission further noted that "such discharge contemplates using 63 grams of zinc (the amount of zinc used in the zinc anode gel mix of the test cell) and there is no dispute that no commercial alkaline cell employs 63 grams of zinc in its anode gel." *Id.* at 123a.

4. On appeal to the Federal Circuit, petitioners contended that the claims were not invalid for indefiniteness because the term "said zinc anode" should be construed to mean "the zinc that is the active anode component." 05-1018 Pet. C.A. Br. 21. The federal respondent argued that so construing the term would constitute impermissible rewriting of the claims because "it would require that the word 'anode' be read out of the term 'said zinc anode.'" 05-1018 Gov't C.A. Br. 32.

The court of appeals reversed and remanded. Pet. App. 76a-88a. In a unanimous opinion, the court held that petitioners' patent claims were not invalid for indefiniteness, "despite [the] lack of explicit antecedent basis for 'said zinc anode,'" because the claim "nonetheless has a reasonably ascertainable meaning." *Id.* at 87a. The court found that, in the context of the claim as a whole, the term "'anode gel' is by implication the antecedent basis for 'said zinc anode.'" *Id.* at 88a. It therefore reversed "[t]he Commission's holding of invalidity on the ground of indefiniteness." *Ibid.*

5. On remand, the Commission applied the Federal Circuit's construction of the term "said zinc anode" and concluded that the asserted claims were invalid for failure to meet the written description requirement of 35 U.S.C. 112 para 1. Pet. App. 61a-70a. The Commission

rejected petitioners' argument that the term "said zinc anode" should be read to mean "said zinc," explaining that the Federal Circuit had necessarily rejected that argument when it concluded that "'said zinc anode' refers to the 'anode gel' of the claimed electrochemical cell." *Id.* at 62a. The Commission further concluded that, even if the patent claims were not invalid for failure to meet the written description requirement, the products imported by the intervenor-respondents did not infringe the claims if the term "said zinc anode" were understood to mean "anode gel." *Id.* at 68a-69a.[3]

6. The court of appeals affirmed. Pet. App. 1a-47a. Judge Schall (*id.* at 4a-25a) and Judge Linn (*id.* at 26a-30a) issued separate unpublished opinions concluding that the patent claims were invalid. Judge Newman dissented. *Id.* at 32a-47a.

a. Judge Schall concluded that the court of appeals' previous decision, which had held "that 'anode gel' is by implication the antecedent basis for 'said zinc anode,'" Pet. App. 15a (quoting *id.* at 88a), "constitute[d] a clear statement of claim construction," *ibid.* He therefore rejected, as "a backdoor attempt to overturn the construction" adopted by the court of appeals in its previous decision, petitioners' argument that the term "said zinc anode" refers to the zinc used to manufacture the anode gel. *Id.* at 17a.

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[3] Two Commissioners dissented. Pet. App. 71a-75a. They would have remanded the case to the ALJ "to construe the remaining claim terms in accordance with the court's holding that the antecedent basis for the 'said zinc anode' is 'anode gel.'" *Id.* at 72a. They expressly concurred, however, with the majority's rejection of petitioners' argument to the extent that they "would have us read the claim term 'said zinc anode' to mean 'said zinc.'" *Id.* at 72a n.1.

Judge Schall concluded that, under the Federal Circuit's decision on the prior appeal, Claim 1 of the '709 patent "unambiguously requires that the anode gel of a battery sold to consumers undergo the discharge test set forth in the specification." Pet. App. 19a. Judge Schall explained, however, that "no commercial battery could be subjected to such a test," *ibid.*, because no such battery "contains anywhere near" the 63 grams of zinc required by the test described in the specification, *id.* at 12a n.3. While noting that the "inventor easily could have avoided this problem by drafting [C]laim 1 so that it read 'said zinc anode *is comprised of zinc that*,'" Judge Schall explained that the inventor had not done so, and that the court of appeals "cannot rewrite the claim." *Id.* at 19a. Judge Schall determined that the asserted claims failed to meet the written description requirement because the specification did not describe the invention claimed to be protected by the claims: the patent's specification described "a test to pre-screen zincs for use in zero-mercury added alkaline batteries to be sold to consumers," but "the claims of the '709 patent were drafted to claim commercial alkaline batteries." *Id.* at 24a.

b. Judge Linn agreed with Judge Schall that the court's previous decision had determined that "anode gel" is the antecedent for the term "said zinc anode." Pet. App. 28a & n.2. In Judge Linn's view, however, the prior decision did not foreclose further consideration of whether the patent claims were invalid for indefiniteness in other respects. Judge Linn noted that the specification must "conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention," *id.* at 28a (quoting 35 U.S.C. 112 para. 2), and he concluded

that the claims were "insolubly ambiguous," *id.* at 30a. He explained that "[t]he claim cannot be interpreted to mean a battery cell with an anode gel having 63 grams of zinc, not only because such a construction is inconsistent with present commercial requirements, but more significantly because that would require an anode gel which expands in accordance with the specifications of the test cell configuration and yet acts in concert with a cathode of the type specified in the commercial battery examples." *Id.* at 29a. "On the other hand," he observed, "to construe the claim to cover what the applicant seems to have intended—namely, a battery cell with an anode containing zinc of a purity determined by use of the disclosed test cell procedure—would require that we rewrite the claim." *Ibid.*

c. Judge Newman dissented. Pet. App. 31a-47a. While recognizing that "the '709 patent's claims are not perfect," she would have held that "the invention that is claimed is the invention that is unambiguously and clearly described in the specification." *Id.* at 32a. She concluded that "[t]he specification shows that the discharge time and conditions and gel expansion parameters are for the test cell." *Id.* at 43a. In her view, the relevant question was "whether [petitioners'] claims in the '709 patent should be construed in accordance with their undisputed intended meaning, as clearly described in the specification and accepted by the patent examiner, or whether this patentee must be punished for a 'disconnect' or 'ambiguity' that has no relation to what was invented." *Id.* at 45a. She would have upheld the validity of the patent claims by construing "the claim's gel expansion criterion as determined by a test procedure" described in the specification. *Id.* at 47a.

ARGUMENT

The decision of the court of appeals is correct and does not present the broad question of claim construction framed in the petition for a writ of certiorari. Further review is not warranted.

1. The decision below is correct. On the first appeal, the court of appeals unanimously concluded that "'anode gel' is by implication the antecedent basis for 'said zinc anode.'" Pet. App. 88a. That construction of the patent claims was necessary to the first panel's holding that the claims were not invalid for indefiniteness for lack of an antecedent for the term "said zinc anode." *Ibid.* So construed, the claims are invalid because there is a "fundamental disconnect" between the claims and the specification. *Id.* at 17a.

That disconnect renders the claims invalid for both of the reasons given by the judges in the majority on the second appeal. First, as Judge Schall concluded, the claims fail the written description requirement because "what is claimed in [C]laim 1 of the '709 patent is not what is described in the patent specification." Pet. App. 23a. Whereas the specification indicates that "the invention of the '709 patent is a *test* to pre-screen zincs for use in zero-mercury added alkaline batteries," the patent's claims encompass the completed batteries themselves. *Id.* at 24a (emphasis added). Second, as Judge Linn concluded, Claim 1 is indefinite because it fails to specify what the applicant regarded as his invention. The patent claims a commercial battery with an anode gel having more zinc than any commercial battery, and it claims a battery cell with "an anode gel which expands in accordance with the specifications of the test cell configuration and yet acts in concert with a cathode of the type specified in the commercial battery examples." *Id.* at

29a. As the Commission explained, moreover, even if the claims were valid, the batteries that respondent-intervenors imported would not infringe the claims because none of those batteries contain the amount of zinc necessary to fall within the scope of the claim when the term "said zinc anode" is construed to mean "anode gel." *Id.* at 68a-69a.

2. a. This case does not implicate the broad principles of claim construction discussed in the petition. See Pet. 16-28. Petitioners assert that the Federal Circuit has two approaches to claim construction: "hypertextualism" and "the pragmatic approach." Pet. 17. According to petitioners, those two approaches reflect different views as to the extent to which judges should look to "sources of expertise outside the patent document," such as expert testimony, Pet. 20, in order to "retain the validity of the claims," Pet. 28.

Even assuming the existence of two such approaches, none of the three opinions on the second appeal turns on the proper use of experts or extrinsic evidence. Instead, all three members of the second panel based their analyses on the language of the patent documents, namely the claims and specification. Judge Schall and Judge Linn each concluded that there was an irreconcilable disconnect between the claims and the specification. See Pet. App. 24a (Schall, J.) ("The problem in this case is that the specification of the '709 patent does not teach what is claimed, whereas the claims of the patent do not claim what is taught."); *id.* at 29a (Linn, J.) (concluding that Claim 1 "can hardly be said to reflect what the applicant regarded as his invention"). Although Judge Newman concluded (*id.* at 32a) that the specification's clarity could be used to save the "not perfect" language of the claims, see, *e.g.*, *id.* at 40a (criticizing the majority for

"simply declin[ing] to read the claims in light of the specification"), she did not base that determination on evidence extrinsic to the patent itself.

Petitioners also suggest (Pet. 27-28) that Judge Schall and Judge Linn took "a hypertextualist approach to the term 'said zinc anode,' refusing to adopt the sensible pragmatic construction" even "while recognizing that there was only one logical interpretation of the claims—'said zinc anode' means 'zinc.'" But petitioners' current contention that the term "said zinc anode" must be construed to mean "said zinc" is contrary to the Federal Circuit's *unanimous* ruling on the first appeal, in an opinion written by Judge Newman, that the term "said zinc anode" means "anode gel." Pet. App. 88a. In their opinions on the second appeal, Judge Schall (*id.* at 17a) and Judge Linn (*id.* at 28a & n.2) simply took that earlier holding as a given and evaluated the validity of the patent claims using that construction. The unanimity of the first decision, as well as the fact that the dissenting judge on the second appeal was the author of that opinion, undermines petitioners' suggestion that the court's construction of "said zinc anode" as "anode gel" is attributable to disarray within the Federal Circuit concerning the proper approach to patent construction.[4]

b. Petitioners' understanding of Claim 1 of the '709 patent suffers from two distinct infirmities. First, as explained above, petitioners' contention that the term

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[4] Relying on a handbook on batteries, petitioners suggest (Pet. 3, 28, 36) that "[p]eople of skill in the art understand that the anode *is* powdered zinc." Pet. 28. In their opening briefs to the Federal Circuit on both appeals, however, petitioners stated: "The anode of an alkaline battery is a gel made by mixing zinc powder, which is the active anode component, with electrolyte and a gelling agent." 05-1018 Pet. C.A. Br. 7; 2007-1197 Pet. C.A. Br. 8.

"said zinc anode" means zinc *powder* reads the word "anode" out of the claims and is inconsistent with the Federal Circuit's unanimous ruling on the previous appeal. Second, even if the term "said zinc anode" could plausibly be understood to refer to the zinc component of the anode gel, the claim literally indicates that the "zinc anode" of each commercial battery must be subjected to a test that no commercial battery could satisfy. See Pet. App. 12a n.3, 19a (Schall, J.); *id.* at 29a (Linn, J.).

At bottom, petitioners' argument is not that the Federal Circuit misconstrued *ambiguous* patent language, but that the court ought to have redrafted their claims in order to save the patent from invalidity. As Judge Linn explained, "to cover what the applicant seems to have intended—namely, a battery cell with an anode containing zinc of a purity determined by use of the disclosed test cell procedure—would require that [the court] rewrite the claim." Pet. App. 29a (Linn, J.); see *id.* at 19a (Schall, J.). But the Federal Circuit "repeatedly and consistently has recognized that courts may not redraft claims, whether to make them operable or to sustain their validity." *Chef Am. Inc.* v. *Lamb-Weston, Inc.*, 358 F.3d 1371, 1374 (Fed. Cir. 2004) (citing cases); see *ibid.* (noting that when "claims are susceptible to only one reasonable interpretation and that interpretation results in a nonsensical construction of the claim as a whole, the claim must be invalidated") (quoting *Process Control Corp.* v. *Hydreclaim Corp.*, 190 F.3d 1350, 1357 (Fed. Cir. 1999), cert. denied, 529 U.S. 1037 (2000)); cf. *United States* v. *Locke*, 471 U.S. 84, 95 (1985) (explaining, with respect to the interpretation of federal statutes, that "the fact that Congress might have acted with greater clarity or foresight does not give courts a

carte blanche to redraft statutes in an effort to achieve that which Congress is perceived to have failed to do").

None of the cases cited by petitioners holds that a court may construe patent language in a manner contrary to its literal terms in order to save the patent claims from invalidity. To the contrary, many of those decisions recognize that such judicial rewriting is prohibited. See, *e.g.*, *Ortho-McNeil Pharm., Inc.* v. *Mylan Labs.*, 520 F.3d 1358, 1362 (Fed. Cir. 2008) ("In *Chef America* * * * this court explained that a patent must be interpreted 'as written, not as the patentees wish they had written it.'") (quoting 358 F.3d at 1374); *Nazomi Commc'ns, Inc.* v. *ARM Holdings, PLC*, 403 F.3d 1364, 1368 (Fed. Cir. 2005) ("[C]ourts should not rewrite claims to preserve validity."); *Rhine* v. *Casio, Inc.*, 183 F.3d 1342, 1345 (Fed. Cir. 1999) ("We have also admonished against judicial rewriting of claims to preserve validity."); *Autogiro Co. of Am.* v. *United States*, 384 F.2d 391, 396 (Ct. Cl. 1967) ("No matter how great the temptations of fairness or policy making, courts do not rework claims.").[5]

The patent holder is rightly held to the consequences of its own poor draftsmanship. The patent laws require the applicant to define claims with specificity, 35 U.S.C. 112, "not only to secure to him all to which he is entitled,

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[5] The amicus brief that the United States filed at the en banc stage in *Phillips* v. *AWH Corporation*, 415 F.3d 1303 (Fed. Cir. 2005), cert. denied, 546 U.S. 1170 (2006) on which petitioner relies (Pet. 34-35), is in accord with that principle. See Gov't Amicus Br. at 17, in Nos. 03-1269, -1286 (Fed. Cir. Sept. 20, 2004) ("[C]laims can only be construed to preserve their validity where the proposed claim construction is practicable, is based on sound claim construction principles, and *does not revise or ignore the explicit language of the claims*.") (emphasis added).

but to apprise the public of what is still open to them." *McClain* v. *Ortmayer*, 141 U.S. 419, 424 (1891). It is "just and fair, both to the patentee and to the public," to expect that the patentee will "understand, and correctly describe, just what he has invented, and for what he claims a patent." *Merrill* v. *Yeomans*, 94 U.S. 568, 573-574 (1877). That is especially true given that the applicant can correct any initial drafting errors by amending the claims during the application process. And even after a patent has been issued, the patent holder has opportunities to amend the claims, either by filing a reissue application or by seeking a certificate of correction. 35 U.S.C. 251, 255.

As Judge Schall observed, petitioners "easily could have avoided" the problems caused by their use of the term "said zinc anode." Pet. App. 19a.[6] Moreover, the term "said zinc anode" resulted from an amendment during the application process, as to which the patent applicant later admitted a mistake: "I think that word 'anode' actually was there in error. It should have said zinc powder that was used in the zinc anode." 2/23/04 Tr. 721-722. Despite that acknowledged mistake, petitioners never sought to further amend that term. Nor did they attempt to change it after the patent was issued, either by seeking a certificate of correction or by

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[6] Indeed, in a related patent, petitioners referred to "[a]n electrochemical cell comprising . . . an anode gel comprised of low expansion zinc which has a gel expansion of less than 25% after being discharged for 161 minutes to 15% depth of discharge at 2.88A." Pet. App. 30a (Linn, J.). As Judge Linn explained, "[i]f the applicant desired coverage of a battery with zinc having specified properties, it should have written [C]laim 1 of the '709 patent the way it wrote [C]laim 1 of its related [patent]." *Id.* at 29a-30a.

requesting reissue of the patent, even though they sought two certificates of correction on other issues.[7]

3. For at least three additional reasons, this case is not a suitable vehicle for resolving the broad question framed in the petition for a writ of certiorari. First, as the various opinions on petitioners' two appeals make clear, the court's resolution of this case is highly fact-bound. Second, the court of appeals' final disposition is unpublished, with no single majority opinion. Third, the court's ultimate resolution of the case—and the crux of petitioners' dispute with the outcome of the proceedings below—flows from the construction given the term "said zinc anode" in the court's decision on the prior appeal. That factbound, unanimous decision would not have warranted review by this Court when it was issued, and there is no reason for a different conclusion now.

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[7] The patent laws establish certain requirements that must be satisfied before a patent may be reissued or a certificate of correction may be granted. See 35 U.S.C. 251, 255. We express no view on whether petitioners could have met those requirements.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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